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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,372	09/23/2003	Toshihide Takahashi	1472-0304P	9207
2292	7590	08/09/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH			TON, ANABEL	
PO BOX 747			ART UNIT	
FALLS CHURCH, VA 22040-0747			PAPER NUMBER	

2875

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/667,372

Applicant(s)

TAKAHASHI, TOSHIHIDE

Examiner

Anabel M. Ton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, filed 05/20/05, with respect to claims 1-4 have been fully considered and are persuasive. The USC 102(b) rejection of claims 1-4 has been withdrawn.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "35" has been used to designate both a positioning projection in page 7 of the specification and positioning hole in page 9 of the specification. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 5, dependent on claim 1, applicant refers to "the engaged part". In claim 1 there is no mention of "the engaged part" but "engaged parts" pertaining to the first temporal fastening member and the second temporal fastening member. It is not clear which "engaged part" applicant is referring to. In claim 6 applicant refers to "the second tempered fastening member". There is no antecedent basis for this limitation in claim 1. Because of their dependency, claims 7-8 are necessarily rejected.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4,6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimichi (JP 11048856).

Shimichi discloses the claimed invention except for the recitation of the first temporal fastening member having a plurality of engaged parts along a protruding

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direction of the positioning projection and the second temporal fastening member having an engaging part adapted to engage with the engaged parts provided by the first temporal fastening member. Simishi discloses an outer panel member mounted frame member of a vehicle and defining of an outer surface the vehicle (6); a lamp unit disposed adjacent to said outer panel member (26); a positioning projection protruding from one of said outer panel member and said lamp (32) a positioning opening formed the other one said outer panel member and said lamp unit (40), said positioning adapted to receive said positioning projection (fig 4); positioning abutment parts provided in said lamp unit and said outer panel member, and said positioning abutment parts abut one another when said positioning projection has been inserted into said positioning hole(38,40), thereby position lamp at a predetermined location along protruding direction said positioning projection; a first temporal fastening member protruding from one of said lamp(34) unit and said frame member , and having an engaging part formed along protruding direction said positioning projection(34h); and a second temporal fastening member provided in the other one said lamp unit and said frame member (44), and having an engaging part(44c) adapted to engage the part provided in said temporal first temporal fastening member, the positioning projection is tapered toward a tip thereof. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have a plurality of positioning projections in the device of Shimichi for the purpose of providing a fastening member with reinforced retaining strength and likewise a second temporal fastening member with a plurality of engaging parts to engage the plurality of fastening members for the purpose the lamp

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mounting apparatus with a reinforced strength for retaining the lamp housing to the frame member of the vehicle. Furthermore, it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. Also for a teaching of retaining members cooperating for mounting lamp housings to a vehicle body with multiple protrusions extending from the retaining members (threading) see cited prior art Naganawa.

- With regards to claim 2, Shimichi discloses a first temporal fastening member being a shaft like (fig 6, 34) member having a projection (34h) formed on an outer circumference thereof in a manner extending along a circumferential direction thereof, at least in an upper portion. With regards to the member having a plurality of projections formed on the outer circumference direction, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a plurality of positioning projections in the device of Shimichi for the purpose of providing fastening member of Shimichi with reinforced retaining strength. Furthermore, it has been held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8;
- With regards to claim 3, Shimichi discloses a second temporal fastening member including an annular member having engaging parts (figs 4 and 6, 41g) adapted to engage with the projection of the first temporal fastening member. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the second temporal fastening member of Shimichi include

engaging parts adapted to engage with multiple projections of the first temporal fastening member since a second temporal fastening member with a plurality of engaging parts to engage the plurality of fastening members from a first member would be purposeful providing the lamp apparatus with a reinforced retaining strength for retaining the lamp housing to the frame member of the vehicle.

- The second temporal fastening member is a clip (pp4, 0024, of translation)
- The clip includes a frame part (44c) and extending parts (44);
- With regards to the frame member being rectangular, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the frame member of Shimichi to be rectangular, since it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). It appears that the disclosed device would perform equally well shaped as disclosed by Shimichi.

Allowable Subject Matter

6. Claim 5 is would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art cited of record does not teach the engaged part includes two parts which oppose each other .

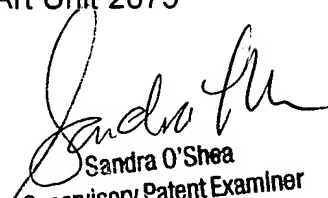
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anabel M. Ton whose telephone number is (571) 272-2382. The examiner can normally be reached on 08:00-16:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMT

Anabel M Ton
Examiner
Art Unit 2875


Sandra O'Shea
Supervisory Patent Examiner
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